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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,197	02/24/2004	Kenji Ando	0445-0347P	9246

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

NOTIFICATION DATE	DELIVERY MODE
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10/10/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/784,197

Applicant(s)

KENJI ANDO

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/27/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/27/07 has been entered.

Response to Arguments

2. Applicant's arguments filed 7/27/07 have been considered but are not persuasive. Applicant argues "It is noted that claim 1 previously recited the alternative presence of 'cut ends' or 'cut fragments' of elastic members, or both. The Examiner appears to consider the ends of elastic members 1527a (Figure 48) or the ends of elastic members 1627a (Figure 49), for example, to have met this limitation. That is, the Examiner appears to have considered the ends of elastic members 1527a or 1627a to be 'cut ends*'. Claim 1, as now amended, now requires the presence of cut 'fragments', as opposed to cut 'ends', in order to more clearly distinguish over the teachings of the reference. It is apparent that the cited reference fails to teach such an embodiment. The Examiner fails to see a significant difference between cut ends and cut fragments as it

relates to the present invention. The elastic materials of Torigoshi has cut ends, which would also fragment the material providing cut fragments of the elastic in the article.

Applicant argues Torigoshi US Patent Application Publication 2004/0030317 fails to whether or not there is a portion substantially non-contributory to elastic extensibility and contractibility where the cut fragments of the elastic are located. Torigoshi teaches elastic members 527, 528, and 527a, and specifically in the front of the diaper where the patterned sheet can be observed, the elastic members 527, 527a have cut fragments (Figures 32 and 34). If the elastics are not present, they characteristically are not contributing to elastic extensibility and contractibility in that region.

Applicant repeats the argument that it is not clear or clearly disclosed in Torigoshi if its pictorial pattern is clearly seen from an outside point of view. Applicant argues the location of the portion that is substantially non-contributory to elastic extensibility and contractability aids in bringing about a pictorial pattern clearly seen from the outside of the diaper and this is missing in Torigoshi. However, Figure 1 of Torigoshi clearly shows the graphic viewable from the external sheet 120, further Torigoshi teaches the character corresponding to the front and back of a product so as to be easily distinguishable by anyone at a glance, which clearly indicates the graphic is viewable from the outside. Applicant additionally argues the cited modification of Torigoshi does not result in a patterned sheet having a pattern is disposed between the outer sheet and the inner sheet as instantly claimed. As stated in the Final Office Action mailed

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11/29/06, Torigoshi discloses a patterned sheet 100 having a pattern disposed between the outer sheet and the inner sheet, which is taught in paragraph 0259.

Applicant further argues Torigoshi does not disclose the recited method of producing the same. As previously stated, the method of forming the device is not germane to the issue of patentability of the device itself. Torigoshi provides the same structure having elastic members 527, 528, and 527a, and specifically in the front of the diaper where the patterned sheet can be observed, the elastic members 527, 527a have cut fragments (Figures 32 and 34). If the elastics are not present, they characteristically are not contributing to elastic extensibility and contractibility in that region.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, and 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torigoshi JP 2002159528, the examiner will reference the English equivalent, which is US Patent Application Publication 2004/0030317.

As to claims 1, 7, 10, and 12, Torigoshi describes an absorbent article and process of making the article (Figures 32-36) having a front portion F and a rear portion B and comprising an outer sheet 20 that provides an outer surface of the absorbent article, an inner sheet 512 disposed on the inner side of the outer sheet, and plurality of elastic members 527, 528, 527a, 527b for making below-waist gathers disposed between the outer sheet and inner sheet (paragraph 0229 and 0231). The article further comprises a patterned sheet 100 having a pattern disposed between the outer sheet and the inner sheet in the widthwise middle area of at least one of the front portion and the rear portion (Figures 50A and 50B and paragraph 0259). The elastic members each have a portion (a) contributory to elastic extensibility and contractibility in each of the regions outside the lateral sides of the patterned sheet, and a portion (b) substantially non-contributory to elastic extensibility and contractibility in the region inside the lateral sides of the patterned sheet (paragraphs 0228, 0229, 0231, and 0232). Torigoshi discloses the elastics are adhered between the nonwoven fabric of the outer sheet 520 (paragraph 0229). Torigoshi discloses the claimed invention except for Torigoshi does not specifically disclose the elastic edges between the patterned sheet

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and inner sheet. Torigoshi discloses the patterned sheet is interposed between the external sheet and additionally can be printed on the outer sheet or the back of the inner sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Torigoshi to have the elastic ends between the patterned sheet and inner sheet since rearranging parts of an invention involves only routine skill in the art.

As to claim 2, Torigoshi discloses a patterned sheet having a graphic on the absorbent article (Figure 1). Torigoshi does not disclose a total transmittance value. High Light transmittance values are known in the art for disposable articles comprising graphics seen through the outer cover of the article. For instance, Jordan et al. US 2001/0031954 teaches a high light transmittance value of 80% or higher for an outer cover graphic (paragraph 0110). Light transmittance values would have been obvious by optimizing the opacity of the film, filler material, or density of the material. Moreover, "discovering optimum values only involves routine skill in the art", *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

As to claims 4-6, and 11 the claims are product claims directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art,

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the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claim 8, Torigoshi discloses the outer sheet 520 is a nonwoven fabric (paragraph 0216).


As to claim 9, Torigoshi discloses a reduced basis weight nonwoven is desired (paragraph 0162) and a basis weight less than 40 gsm is preferred (paragraph 0284). To discover the optimal basis weight for the intended use only involves routine skill in the art, *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jacqueline F Stephens
Primary Examiner
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October 1, 2007